

Docket No.: 0933-0247PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jukka T. SALONEN et al.

Application No.: 10/538,198

Confirmation No.: 1824

Filed: January 6, 2006

Art Unit: 1634

For: METHOD AND KIT FOR DETECTING A
RISK FOR DIABETES OR A METABOLIC
SYNDROME

Examiner: K. D. Salmon

LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

After review of the Examiner's Restriction Requirement issued January 15, 2008, Applicants' note that the USPTO has erroneously entered as the Specification and claims for the present application the specification and claims from Applicants' previous PCT application PCT/FI2002/00113.

The current application was filed as the National Stage application of International Application No. PCT/FI2003/000946, which has the international filing date of December 11, 2003, as can be seen by the attached New Application Transmittal and Application Data Sheet submitted for the current application on June 9, 2005.

Applicants note that the Specification and claims listed in the PAIR Image File Wrapper for the above-identified application are actually from PCT/FI2002/00113. This is a previous PCT

application of the Applicants, published as WO 02/066617 that was submitted with an Information Disclosure Statement on June 9, 2005 and filed as prior art related to the present invention. As such, Applicants believe that the USPTO erroneously entered the Specification and claims from PCT/FI2002/00113 as the present application instead of those of the correct PCT/FI2003/000946 application.

Applicants respectfully request that:

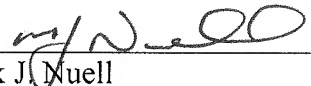
- 1) the Examiner PROMPTLY withdraw and vacate the Restriction Requirement mailed January 15, 2008 in the present application,**
- 2) enter as the proper specification and claims for this application those of International Application number is PCT/FI2003/000946, published as WO 2004/053158, filed June 9, 2005,**
- 3) review the claims of the proper application, and**
- 4) issue an appropriate Office Action.**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell Reg. No. 36,623 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: March 7, 2008

Respectfully submitted,

By 
Mark J. Nuell

Registration No.: 36,623

BIRCH, STEWART, KOLASCH & BIRCH, LLP

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Attorney for Applicant

Application Data Sheet

Application Information

Application Type:: Regular
Subject Matter:: National Phase
Suggested Group Art Unit:: N/A
CD-ROM or CD-R?: None
Sequence submission?: None
Computer Readable Form (CRF)?:: No
Title:: METHOD AND KIT FOR DETECTING A
RISK FOR DIABETES OR A METABOLIC
SYNDROME
Attorney Docket Number:: 0933-0247PUS1
Request for Early Publication?: No
Request for Non-Publication?: No
Total Drawing Sheets:: 0
Small Entity?: Yes
Petition included?: No
Secrecy Order in Parent Appl.?: No

Applicant Information

Applicant Authority Type:: Inventor
Primary Citizenship Country:: Finland ✓
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Country of mailing address:: Finland
Postal or Zip Code of mailing address:: FI-70100

10/538198

JC17 Rec'd PCT/PTO 09 JUN 2005

Applicant Authority Type:: Inventor
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Postal or Zip Code of mailing address:: FI-70100

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JC17 Rec'd PCT/PTO 09 JUN 2005

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City of mailing address:: Lahore
Country of mailing address:: Pakistan
Postal or Zip Code of mailing address:: 54000

Correspondence Information

Correspondence Customer Number:: 02292

Representative Information

Representative Customer Number:: 02292

Domestic Priority Information

Application::	Continuity Type::	Parent Application::	Parent Filing Date::
This Application is a	National Stage of	PCT/FI2003/000946	12/11/03

Foreign Priority Information

Country::	Application number::	Filing Date::	Priority Claimed::
FINLAND	20022178	12/11/02	Yes

Assignee Information

Assignee name:: Oy Jurilab Ltd
Street of mailing address:: Microkatu 1
City of mailing address:: Kuopio
Country of mailing address:: Finland
Postal or Zip Code of mailing address:: FI-70210

TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371		ATTORNEY'S DOCKET NUMBER 0933-0247PUS1 ✓
INTERNATIONAL APPLICATION NO. PCT/FI2003/000946 ✓		U.S. APPLICATION NO. 10/538198 NEW
INTERNATIONAL FILING DATE 11 December 2003 ✓		PRIORITY DATE CLAIMED 11 December 2002 ✓
TITLE OF INVENTION METHOD AND KIT FOR DETECTING A RISK FOR DIABETES OR A METABOLIC SYNDROME		
APPLICANT(S) FOR DO/EO/US Jukka T. SALONEN; Mia PIRSKANEN; Tomi-Pekka TUOMAINEN; Faisal YUNUS		

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a submission under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a submission under 35 U.S.C. 371.
3. ☐ This is an express request to begin national examination procedures (35 U.S.C. 371 (f)). The submission must include items (5), (6), (9) and (21) indicated below.
4. ☐ The US has been elected (Article 31).
5. ☒ A copy of the International Application as filed (35 U.S.C. 371 (c)(2))
 - a. ☒ is attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ has been communicated by the International Bureau.
 - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☐ An English language translation of the International Application as filed (35 U.S.C. 371 (c)(2)).
 - a. ☐ is attached hereto.
 - b. ☐ has been previously submitted under 35 U.S.C. 154(d)(4).
7. ☒ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371 (c)(3))
 - a. ☐ are attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ have been communicated by the International Bureau.
 - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
 - d. ☒ have not been made and will not be made.
8. ☐ An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371 (c)(3)).
9. ☐ An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)).
10. ☒ An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371 (c)(5)).

Items 11 to 20 below concern document(s) or information included:

11. ☒ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. ☐ A preliminary amendment.
14. ☒ An Application Data Sheet under 37 CFR 1.76.
15. ☐ A substitute specification.
16. ☐ A power of attorney and/or change of address letter.
17. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 - 1.825.
18. ☐ A second copy of the published International Application under 35 U.S.C. 154(d)(4).
19. ☐ A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).
20. ☒ Other items or information: PCT/IB/304; PCT/ISA/210; PCT/IPEA/409; Sequence Listing (10 Sheets); Zero (0) Sheets of Formal Drawings

The PTO did not receive the following
 listed item(s) Foreign reference
 that indicated in Form 1449.

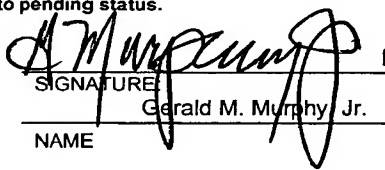
JC17 Rec'd PCT/PTO 09 JUN 2005

PTO-1390 (Rev. 02-2005)

Approved for use through 03/31/2007. OMB 0651-0021

U. S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

U.S. APPLICATION NO. 200538198 NEW		INTERNATIONAL APPLICATION NO. PCT/FI2003/000946		ATTORNEY'S DOCKET NUMBER 0933-0247PUS1	
The following fees have been submitted					
21.	<input checked="" type="checkbox"/> Basic national fee	\$300		CALCULATIONS	PTO USE ONLY
				\$ 300.00	
22.	<input checked="" type="checkbox"/> Examination fee				
If International preliminary examination report prepared by USPTO and all claims satisfy provisions of PCT Article 33(1)-(4).....			\$100		
All other situations			\$200	\$ 200.00	
23.	<input checked="" type="checkbox"/> Search fee				
Search fee (37 CFR 1.445(a)(2)) has been paid on the international application to the USPTO as an International Searching Authority.....			\$100		
International Search Report prepared and provided to the Office			\$400		
All other situations			\$500	\$ 400.00	
TOTAL OF 21, 22 and 23 =				\$ 900.00	
<input type="checkbox"/> Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing or computer program listing filed in an electronic medium). The fee is \$250 for each additional 50 sheets of paper or fraction thereof.					
Total Sheets	Extra sheets	Number of each additional 50 or fraction thereof (round up to a whole number)	RATE		
36 - 100 =	/50 =		x \$250.00		
Surcharge of \$130.00 for furnishing the oath or declaration later than 30 months from the earliest claimed priority date (37 CFR 1.492 (e)).				\$ 130.00	
CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE		
Total claims	33 - 20 =	13	x 50.00	\$ 650.00	
Independent claims	3 - 3 =		x	\$ 0.00	
MULTIPLE DEPENDENT CLAIM(s) (if applicable)			+ 360.00	\$ 360.00	
TOTAL OF ABOVE CALCULATIONS =				\$ 2,040.00	
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Fees above are reduced by 1/2.				\$ 1,020.00	
SUBTOTAL =				\$ 1,020.00	
Processing fee of \$130.00 for furnishing the English translation later than 30 months from the earliest claimed priority date (37 CFR 1.492 (f)).				+	\$
TOTAL NATIONAL FEE =				\$ 1,020.00	
Fee for recording the enclosed assignment (37 CFR 1.21 (h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property				+	\$
TOTAL FEES ENCLOSED =				\$ 1,020.00	
				Amount to be refunded:	\$
				Amount to be charged:	\$
<p>a. <input checked="" type="checkbox"/> A check in the amount of \$ 1,020.00 to cover the above fees is enclosed.</p> <p>b. <input type="checkbox"/> Please charge my Deposit Account No. _____ in the amount of \$ _____ to cover the above fees. A duplicate copy of this sheet is enclosed.</p> <p>c. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 02-2448. A duplicate copy of this sheet is enclosed.</p> <p>d. <input type="checkbox"/> Fees are to be charged to a credit card. WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <p>NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137 (a) or (b)) must be filed and granted to restore the International Application to pending status.</p> <p>SEND ALL CORRESPONDENCE TO:</p> <p style="text-align: right;">  SIGNATURE Gerald M. Murphy Jr. NAME </p> <p>Date: June 9, 2005</p> <p>CUSTOMER NUMBER 02292</p> <p style="text-align: right;">28,977 REGISTRATION NUMBER</p>					

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In re Patent Application of:
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Application No.: Not Yet Assigned

Confirmation No.: N/A

Filed: June 9, 2005

Art Unit: N/A

For: METHOD AND KIT FOR DETECTING A
RISK FOR DIABETES OR A METABOLIC
SYNDROME

Examiner: Not Yet Assigned

LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The PTO is requested to use the amended sheets/claims attached hereto (which correspond to Article 19 amendments or to claims attached to the International Preliminary Examination Report (Article 34)) during prosecution of the above-identified national phase PCT application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §1.16 or 1.14; particularly, extension of time fees.

107538198

Application No.: Not Yet Assigned

Docket No.: 0933-0247PUS1

JC17 Rec'd PCT/PTO 09 JUN 2005

Dated: June 9, 2005

Respectfully submitted,

By 

Gerald M. Murphy, Jr.

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Attachment(s)